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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/737,492 03/19/97 BURMEISTER

EXAMINER

QM31/0513

VIDAS ARRETT & STEINKRAUS
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA MN 55343

ART. UNIT	PAPER NUMBER
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13

3738
DATE MAILED:

05/13/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on February 8, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 21 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 21 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Interference

Claim 21 is rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. 5,601,593 was granted; see MPEP 2307. US Patent 5,601,593 issued on February 11, 1997. The present claim was not filed until September 4, 1998. Also, the first set of amended claims (i.e. the first amendment to the application) were not filed until February 20, 1998. For this reason, only the originally filed claims were filed before the 1 year anniversary date of the patent. Therefore, an analysis of those claims alone is required to determine if the Applicant was claiming the same or substantially the same invention within one year; see MPEP 2307.

An analysis of the originally filed claims clearly shows that the Applicant was not claiming the same or substantially the same invention within one year. Specifically, the originally filed claims did not claim "two groups of wires meshed together" and "two groups of wires of material having different shape memories".

Claim 21 of this application have been copied from claim 1 exactly of U.S. Patent No.5,601,593 for the purpose of an interference.

Response to Arguments

Applicant's arguments filed February 8, 1999 have been fully considered but they are not persuasive. In addition, the showing under 37 CFR 1.607 is insufficient to show that the same invention was claimed within one year from the issue date of the patent.

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Specifically, claims 9 and 12 of the showing (see page 3 of the amendment filed February 8, 1999) do not correspond to any of the originally filed claims of this application. Since the originally filed claims were the only ones which were present in the present case within a year of the patent issue date, Applicant can only rely thereon. The originally filed claims are those filed March 19, 1997 under Article 34 not those filed November 18, 1996. Furthermore, even if Applicant could call the 18 November ¹⁹⁹⁶ 1998 claim set the original claim set, the Applicant was not claiming the same invention or substantially the same invention as claimed in either claims set. Notably, both original claim sets fail to claim "at least two groups of wires meshed together" and "two groups of wires are of a material having shape memory". Claim 15 of the March 19, 1997 claim set and claim 12 of the November 18, 1996 claim set appear to the closest to the proposed count. However, both of these claims are concerned with the wires of a multifilament strand; see Figure 15 and 16 as well as page 13 of the specification which sets forth the claimed subject matter. **Note that the filaments or wires of the multifilament strand are disclosed as having different shape memory properties and not the different strands of a braided tubular structure as set forth and claimed in the Freitag patent.** Furthermore, a mesh is defined as an open network of fibers not merely a strand of many filaments as set forth in original claim 15 and November 18, 1996 filed claim 12. For these reasons, it is the Examiner's position that both original claim sets were clearly claiming a different invention which was patentably distinct from the proposed count; see 37 CFR 1.601(n) which sets forth the standard of similarity required by 35 USC 135(b).

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
Art Unit 3738